

REMARKS

Applicants thank the Examiner for the removal of the previous 35 U.S.C. § 112, 2nd paragraph rejection.

I. Status of Claims

Claims 11-34 are pending in this application. Claims 11, 20, 21, 30, and 33 have been amended. Claim 26 has been amended to more particularly point out Applicants' claimed invention. No new matter has been introduced.

II. Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 29 and 30 have been rejected under 35 U.S.C. § 112 as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as the invention. First, the Examiner alleges that claim 29 is unclear as to whether a treatment or bioassay is claimed. Official Action at page 2. Second, the Examiner alleges that claim 30 is unclear as to what is the intended disease. Official Action at page 2.

Regarding claim 29, Applicants assert that it is not necessary to specifically claim a treatment or a bioassay. Claim 29 recites "A method for activating at least one soluble guanylate cyclase" In addition to being fully supported by the specification at pages 33 and 34, one skilled in the art would appreciate, for example, that activating a soluble guanylate cyclase results in catalyzing the conversion of guanosine triphosphate to cyclic guanosine monophosphate and pyrophosphate. Thus, cyclic guanosine monophosphate and pyrophosphate are the products of the method of activating soluble guanylate cyclase. The claim encompasses at least a novel chemical reaction. The Applicants respectfully remind the Examiner that novel routes to known

chemical species are claimed every day. Accordingly, Applicants respectfully request that the Examiner remove the rejection of claim 29.

Claim 30 recites "A method for treating at least one disorder associated with a disturbed cGMP balance" Applicants respectfully traverse this rejection. An aspect of the present invention, is the use of compounds of formula I for the normalization of a disturbed cGMP balance in the treatment and prophylaxis of diseases associated with a disturbed cGMP balance. Specification at page 21. The specification further provides a list of exemplary diseases that are associated with a disturbed cGMP balance. *Id.* The art is replete with these associations. As such, Applicants respectfully disagree that Applicants have failed to particularly point out their claimed invention. Nevertheless, in order to advance prosecution, Applicants have amended claim 30 such that specific diseases are recited therein, notably diseases that the Examiner has acknowledged as supported by the specification in the Official Action at pages 3 and 4. Accordingly, Applicants request the immediate withdrawal of this rejection.

III. Rejection under 35 U.S.C. § 112, First Paragraph

Claims 29, 30, and 33 have been rejected under 35 U.S.C. § 112, first paragraph because, according to the Examiner, "the specification, while being enabling for the treatment of hypertension, stroke, angina pectoris, or myocardial infarct, does not reasonably provide enablement for the treatment of other diseases such as: atherosclerosis, thrombosis, bronchial asthma, chronic renal insufficiency, diabetes, liver cirrhosis, etc." Official Action at 3.

In the rejection of claim 29, the Examiner alleges that the claim is not specific to the treatment of any disease. For the reasons discussed above, Applicants respectfully

disagree. Again, Applicants assert that the claim need not recite the treatment of a disease. As discussed above, claim 29 recites a method for activating soluble guanylate cyclase. As supported by the specification at pages 33 and 34, claim 29 encompasses at least a novel chemical reaction. Accordingly, Applicants respectfully request that this rejection be withdrawn.

In the rejection of claim 30, the Examiner similarly alleges that the claim is not specific to a certain treatment. For the reasons discussed in the response to the § 112, second paragraph, rejection above, Applicants disagree, but have amended claim 30 in order to further prosecution. Accordingly, Applicants have recited in claim 30 the treatment of specific diseases which the Examiner has acknowledged are supported by the specification (Official Action at page 4).

In the rejection of claim 33, the Examiner made reference to claim 34. Official Action at page 4. Applicants respectfully assume the reference to claim 34 was in error and the Examiner was referring to claim 33. The Examiner alleges that "claim [33] recites the treatment of many disorders . . . all of which may or may not be related to cGMP or guanylate cyclase." Official Action at page 4. For the reasons discussed above, Applicants disagree, but in order to further prosecution, Applicants have amended claim 33 such that claim 33 recites the treatment of only those diseases which the Examiner has acknowledged are supported by the specification (Official Action at page 4). Accordingly, Applicants respectfully request the removal of this rejection.

IV. Rejection under 35 U.S.C. § 102(b)

Claims 11, 20, 21, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Taniguchi et al. JP 10-87492. Specifically, the Examiner references the third compound on column 20 as anticipating these claims. In order to further prosecution, but without acquiescing to this rejection, Applicants have amended claims 11, 20, and 21 such that any compound found within Taniguchi is outside the scope of Applicants' claimed invention. Thus, the rejection of claims 11, 20, 21, and 28 in view of Taniguchi should now be moot. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claims 11, 20, 21, and 28-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al. US 5,436,233, US 5,439,895, and EP 579, 496. Specifically, the Examiner references Example 6(cc) in Lee as anticipating these claims. In order to further prosecution, but without acquiescing to this rejection, Applicants have amended claims 11, 20, and 21 such that any compound found within Lee is outside the scope of Applicants' claimed invention. Thus, the rejection of claims 11, 20, 21, and 28-34 in view of Lee should now be moot. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claims 11, 20, 21, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Giencke et al. (US 5,250,530 or EP 407,899). Specifically, the Examiner references several compounds found within Giencke's Table A. In order to further prosecution, but without acquiescing to this rejection, Applicants have amended claims 11, 20, and 21 such that any compound found within Giencke is outside the scope of Applicants' claimed invention. Thus, the rejection of claims 11, 20, 21, 27 and 28 in

view of Giencke should now be moot. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claims 11, 20, 21, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Albrecht et al (CA 86:29739). In order to further prosecution, but without acquiescing to this rejection, Applicants have amended claims 11, 20, and 21 such that any compound found within Albrecht is outside the scope of Applicants' claimed invention. Thus, the rejection of claims 11, 20, 21, and 28 in view of Albrecht should now be moot. Accordingly, Applicants respectfully request that this rejection be withdrawn.

V. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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